

REMARKS

STATUS OF THE CLAIMS

Claims 1-69 are pending. Claims 4-17, 19-24, 26, 27, 29-37, 40-42, and 59-69 have been withdrawn from consideration. Applicants acknowledge, with appreciation, that the Examiner has withdrawn the rejection of claims 1-3, 18, 25, 28, 38, 39, and 43-58 under 35 U.S.C. § 112, second paragraph.

REJECTIONS UNDER 35 U.S.C. § 103

Claims 1-3, 18, 25, 28, 38, 39, and 43-58 remain rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Janchipraponvej (U.S. Patent No. 4,954,335) in view of Sweger et al. (U.S. Patent No. 5,482,704) and Martino et al. (U.S. Patent No. 6,210,689). Applicants respectfully traverse this rejection for the reasons of record and for the following additional reasons.

In order to establish a prima facie case of obviousness, the Examiner bears the burden of showing that: (1) there is a suggestion or motivation to modify or combine reference teachings, (2) there is a reasonable expectation of success in making such a modification or combination, and (3) the prior art reference, or references when combined, teach or suggest all claim limitations. MPEP § 2143. Here, the Examiner has not met this burden, in particular because the Examiner has failed to establish a suggestion or motivation to combine the teachings of Janchipraponvej with those of Sweger and Martino so as to obtain Applicants' claimed invention.

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1. **Combining the Teachings of Janchipraponvej with the Teachings of Sweger by Substituting CEPA Starch for Polyacrylic Acid Derivatives in the Compositions of Janchipraponvej Would Render Those Compositions Unsatisfactory for Their Intended Purpose**

Janchipraponvej teaches that his disclosed compositions are "clear hair-treating" compositions. (Janchipraponvej, col. 1, lines 7-8). In fact, the reference repeatedly and consistently recites "clear hair-treating composition" in the title, in the abstract, and at least 46 times before even discussing the Examples. The reference emphasizes that the compositions of the invention must be clear, and used this as a basis to distinguish the invention disclosed therein over several pieces of prior art, including Nachtigal, Bolich et al., and a Japanese reference. (Col. 4, lines 1-55.) The reference teaches that obtaining such clear compositions requires a delicate balancing of its five essential ingredients. For example, the reference states:

It has been found that if the polyhydric compound is present in an amount of greater than about 30% by weight of the composition that the clarity of the composition is reduced. Furthermore, if the polyhydric compound is present in the composition in an amount below about 10% by weight, then the conditioner composition is not clear.

(Col. 15, lines 38-46.) The reference further states:

Examples 18 through 21 demonstrate the effect of eliminating at least one of the essential ingredients from the composition. In each of Examples 18 through 21, the composition was **opaque and unstable**, separating into distinct aqueous and nonaqueous phases within a short time period.

(*Id.*, col. 20, lines 49-54 (emphasis added).) The reference states that the clear hair-compositions contain five essential ingredients and further states that:

In addition to the five above-described essential ingredients, **other common cosmetic components and additives that can be incorporated** with the essential ingredients of the

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present invention, **as long as the basic properties of the hair-treating composition, such as clarity** of the composition and an ability to impart hair conditioning properties to hair, **are not adversely affect d.**

(*Id.*, col. 15, lines 47-54 (emphasis added).) Among the optional additives that can be incorporated are thickeners, such as polyacrylic acid derivatives. (*Id.*, col. 16, lines 9-15.) No mention is made of modified starches, such as CEPA-starch, for use as thickeners in the disclosed compositions.

So, in order for the Examiner's modifications to be appropriate, one of ordinary skill in the art would need to jump through several hoops in order to make the proposed modification. In particular, one would need to conclude, *inter alia*: (1) that an optional additive needs to be added to the composition, (2) that the additive should be a thickener, (3) that the thickener should be polyacrylic acid derivatives, and (4) that the polyacrylic acid derivatives are not such great thickeners and that CEPA is a better thickener. The problem lies at least in step (4) because despite the Examiner's suggestion, the selection of CEPA-starch as the optional additive thickener would adversely affect the clarity of the composition. That is, this selection would fly in the face of the teachings of Janchipraponvej at col. 15, lines 47-54.

Applicants respectfully submit that substitution of CEPA-starch for polyacrylic acid derivatives in the compositions of Janchipraponvej would render those compositions less clear, and hence, unsatisfactory for their intended purpose. Where the "proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." MPEP § 2143.01 (citing *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984)).

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In the present case, polyacrylic acid derivatives, such as Carbopol® are specifically known for their clarity in aqueous solutions. See attached product information sheet re CARBOPOL®, www.personalcare.noveoninc.com/products/carbopol/940.asp. In contrast, modified starches, such as CEPA-starch are not known for their clarity in aqueous solutions. Instead, starches have been disclosed as imparting increased opacity in cosmetic formulations to which they are added. (See, e.g., U.S. Patent No. 6,475,500 to Vatter et al., col. 12, line 63, to col. 13, line 13 (noting that starches are useful in imparting opacity in cosmetic compositions as pigments), a copy is attached for the Examiner's convenience.)

According to the Examiner, it would have been obvious to modify the teachings of the cited references by substituting CEPA-Starch, as taught by Sweger into the compositions of Janchipraponvej because "the conclusions of Sweger that CEPA-starch 'is actually superior to the Carbopol standard' (col. 9, lines 2-3) would have suggested to one of ordinary skill in the art the desirability of substituting CEPA-starch for Carbopol® as thickeners or emulsion stabilizers in cosmetic compositions for the treatment of skin and hair." (Office Action, page 4.)

However, this rationale fails to consider the primary objective of Janchipraponvej, which is a "clear hair-treating composition." The objective evidence on the record clearly indicates that while CEPA-starch may be superior to CARBOPOL® regarding thickening, it is inferior to CARBOPOL® in other areas, such as clarity of a composition. In view of this knowledge, the Examiner has failed to explain why one of ordinary skill in

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the art would ignore the explicit requirements for the composition of Janchipraponvej and willy-nilly substitute CEPA-starch for polyacrylic acid derivatives.

In support of this position, Applicants submit the attached Declaration Under 37 C.F.R. § 1.132 executed by Mme. Mahe. In the Declaration, Mme. Mahe states that she prepared according to the method of Example 1 of Janchipraponvej a composition using the ingredients of Example 25, which resulted in a clear composition, as reported by Janchipraponvej, and as verified by the bottle on the left in the photograph attached to the Declaration. Mme. Mahe then added 0.1% of CEPA -starch to this composition, which resulted in a cloudy composition, as shown by the bottle on the right of the photograph attached to the Declaration.

Therefore, for this additional reason, Applicants respectfully request that the rejection under 35 U.S.C. § 103 be withdrawn.

2. Combining the Teachings of Janchipraponvej with the Teachings of Martino by Adding Alkyl Ether Sulfate Salts as Anionic Surfactants to the Compositions of Janchipraponvej Would Render Those Compositions Unsatisfactory for Their Intended Purpose

The Examiner also asserts that a person of ordinary skill in the art would be motivated to combine alkyl ether sulfate salts as anionic surfactants to the compositions of Janchipraponvej. Applicants respectfully submit that, in view of the teachings of Janchipraponvej, a person of ordinary skill in the art would not be motivated to make such a combination.

As discussed above, the compositions of Janchipraponvej are "clear, homogeneous" conditioning compositions. Nothing in Janchipraponvej teaches or

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suggests that anionic surfactants, such as alkyl ether sulfate salts, would be desirable additives to such compositions. To the contrary, the reference states that:

the hair normally is left in a cosmetically-unsatisfactory state after washing with an anionic surfactant-based hair shampoo. Anionic surfactants not only remove the dirt and soil from the hair, but also remove essentially all of the sebum naturally present on the surface of hair fibers. Therefore, it was found that the desirable properties of anionic surfactants that effectively clean the hair also serve to leave the hair in a cosmetically-unsatisfactory condition.

(Janchipraponvej, col. 1, line 61, to col. 2, line 1). The reference then states that conditioning compositions are needed to counteract the effects of anionic surfactant containing shampoo compositions, after which it discloses conditioning compositions according to the invention disclosed therein. In view of this disclosure, Applicants respectfully submit that the Examiner has failed to explain why one of ordinary skill in the art would ignore these explicit teachings and would instead add anionic surfactants, such as alkyl ether sulfate salts, to the conditioning compositions of Janchipraponvej.

In addition, Applicants note that Janchipraponvej teaches that quaternary ammonium compounds, which are cationic compounds, are essential components of his disclosed compositions. (*See id.*, col. 5, lines 37-43.) Cationic compounds are known to have the ability to complex with anionic surfactants, which are foaming surfactants. This complex is water insoluble and the resulting compositions are not clear. Janchipraponvej, however, teaches that his disclosed conditioning compositions must be clear. Accordingly, for this additional reason, Applicants submit that the Examiner has failed to explain why one of ordinary skill in the art would have been motivated to add anionic surfactants, such as alkyl ether sulfate salts, to the compositions of Janchipraponvej when it is taught that such an addition could result in a complex, which

would render the resulting composition unclear and, hence, unfit for its intended purpose.

The Examiner states in the Advisory Action that Martino is relied upon for providing the motivation to add the surfactants to Janchipraponvej's composition because Martino teaches that surfactants, such as alkyl ether sulfate salts, are well known for their use in cosmetic compositions (col. 5., lines 10-15). Irrespective of whether this is a true reading of Martino, it is ignoring the teachings of Janchipraponvej. In essence, the Examiner is picking and choosing certain disclosures from various references in an attempt to achieve the claimed invention. However, "[i]t is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." *In re Wesslau*, 353 F.2d 238, 241, 147 U.S.P.Q. 391, 393 (C.C.P.A. 1965); *see also Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443, 448-49, 230 U.S.P.Q. 416, 420 (Fed. Cir. 1986) (holding that district court, by failing to consider a prior art reference in its entirety, ignored portions of the reference that led away from obviousness).

For all of the above reasons, the Examiner has failed to establish a prima facie case of obviousness. Applicants respectfully request that the rejection under 35 U.S.C. § 103 be withdrawn.

CONCLUSION

Applicants respectfully request the reconsideration of this application and the timely allowance of the pending claims. If the Examiner believes a telephone

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conference could be useful in resolving any outstanding issues in this case, he is respectfully invited to contact Applicants' undersigned counsel at 571.203.2712.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
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Dated: December 1, 2003

By: Carol L. Cole
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Attachments

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